

and 10 stand rejected under § 103(a) as being unpatentable over the '787 reference in view of *Sato et al.* (U.S. Pat. No. 5,617,389); and claim 8 stands rejected under § 103(a) as being unpatentable over the '787 reference in view of *Sato et al.* and further in view of the *Hoshi* '065 reference.

Applicant appreciates the notice that claims 12-18 would be allowable if rewritten in independent form.

With respect to the claim objections, Applicant respectfully traverses. Each of claims 2, 3 and 8 has clear support in the Specification. The mathematical terms themselves are, by definition provided in the claims, directly corresponding to the mathematical terms used in the Specification. For example, claim 2 defines the objected-to term as follows: "l(n-m) is the time difference between detector signals of sub-detectors m and n". This definition, and those provided in claims 3 and 8, are consistent with the terms used at pages 6-7 of the Specification. The Board has considered such antecedent-basis rejections/objections in other cases and has held that a claim satisfies the requirements if it would be reasonably ascertainable by those skilled in the art. *See, e.g., Ex parte Porter*, 25 U.S.P.Q.2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provides reason-able antecedent basis for "the controlled fluid" and, therefore, the claim is not indefinite and sufficient antecedent basis is provided). Should the rejection be maintained, Applicant would request clarification as to which aspect is lacking support in the Specification.

In view of the above, Applicant respectfully requests that the objection be removed.

Applicant respectfully traverses each of the § 102(b) and § 103(a) rejections.

With respect to the § 102(b) rejection, Applicant respectfully submits that the rejection is improper as the cited portions of the '787 reference fail to teach or disclose all aspects of the claimed invention. For example, the Office Action cites column 7, line 41 of the '787 reference in support of the assertion that the claimed detection system is taught by the '787 reference. However, the only items mentioned at column 7, line 41 of the '787 reference are a lens, a recording medium and a pit. None of these three items could possibly correspond to a detection system as claimed. The Office Action goes on to allege that this so-called detection system (whatever that may be) includes the

particular detectors and circuitry as claimed. The only citation in support of this allegation is the open-ended reference to column 8, lines 52 through column 10, line 60 and column 12, line 59.

A careful review of column 8, lines 52 through column 10, line 60 and column 12, line 59 reveals a detailed discussion of figures 5 through 7 of the '787 reference. However, neither these figures nor the associated discussion corresponds to Applicant's claimed detection system, plurality of detectors and electronic circuitry.

Accordingly, Applicant respectfully submits that the asserted interpretation of the '787 reference is flawed in its application generally and specifically for the rejection of independent claim 1. Because this flawed interpretation is relied upon in connection with each of the §102 and §103 rejections, Applicant respectfully submits that each of these prior-art rejections is improper and should be removed.

In addition, Applicant submits that the Examiner has presented substantially the same rejections without providing a substantive response to the issues previously raised by Applicant. For example, Applicant argued that the '787 reference does not teach "an electronic circuit . . . for generating a time difference signal representing a wavefront aberration, specifically focus error" as alleged in the Office Action. However, the Office Action essentially ignored this issue by the broad-brushing statement: "see above." The Office Action similarly ignored the issues raised in connection with claims 2-5, and altogether ignored Applicant's arguments that the asserted combinations fail to be accompanied by any evidence that the skilled artisan would be led by the prior art to implement the combined teachings as claimed.

In view of the lack of substantive response, Applicant submits that the Office Action does not comply with, among other requirements, MPEP §707.07(I) and 35 U.S.C. §132.

More particularly and with respect to claims 1 and 9, and claims depending therefrom, the Office Action does not address the issues relating to the claimed "time difference" as discussed in the previous Office Action Response. Thus, as previously argued, a time difference signal representing a wavefront aberration is not identically taught by a disclosure of a time difference signal representing a focus error.

With respect to the rejection of claims 7 and 10, the Office Action now acknowledges that the '787 reference does not teach a detection system comprising eight detectors arranged in four quadrants, each quadrant being split at a radius in an inner part and an outer part. For this deficiency, the Office Action relies upon the teachings of *Satoh* and attempts to combine the teachings of *Satoh* with the detection system of the '787 reference. This combination, however, is untenable because the detection system of the '787 reference does not exist. Moreover, implementing any of these teachings of *Satoh* into the embodiment taught by the '787 reference would not result in any operable system for any purpose. There is simply no motivation and the Office Action fails to cite any evidence to the contrary.

Similarly with respect to the § 103(a) rejection of claims 2 and 3, Applicant respectfully submits that the rejection is improper because the cited references are also presented in an attempt to modify a detection system that has not been identified. A *prima facie* case of obviousness requires a complete correspondence between the asserted prior art and the claimed invention, and the Office Action has failed in this regard. Applicant requests that the § 103(a) rejection of claims 2 and 3 be removed.

With respect to the § 103(a) rejection of claims 4-5, Applicant respectfully submits that the rejection is improper because the cited references (the '787 reference, in view of the '552 reference) fail to establish a *prima facie* case of obviousness. Specifically, Applicant fails to see among the cited reference portions, *inter alia*, the claimed detection system. The cited detection system of the '552 reference (item 614 of figure 16) is a tracking-error, focusing-error detection system that does not correspond to the invention set forth in claims 4-5.

Applicable to each of the prior art rejections, the '787 reference fails to teach the various claimed features discussed above. This misinterpretation of the '787 reference has been relied upon in the assertions of each of these rejections. Furthermore, in connection with the § 103(a) rejections, no evidence of motivation has been cited in support of the asserted combinations. Therefore, the Office Action has again failed to establish a *prima facie* case of obviousness, and Applicant requests that the §§ 102 and 103(a) rejections be removed.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the attorney overseeing the application file, Mr. Eric M. Bram, of Philips Corporation at (914) 333-9635.

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